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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,847	01/16/2004	Larry G. Tang	PU2188	1846
23454	7590	05/21/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,847	TANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sebastiano Passaniti	3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 01/16/2004 – application papers filed.

The cross-reference to related applications is contained on the first page of applicant's specification. The reference to prior applications will not be repeated here, for brevity.

Claims 1-9 are pending.

Following is an action on the MERITS:

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 7 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8 of prior U.S. Patent No. 6,679,782. Applicant is advised that instant claim 7 and patented claim 8 of the '782 Patent are so close in content that they both cover the same thing, despite a slight difference in wording. This is a double patenting rejection.

Claim 8 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,679,782. Applicant is advised that instant claim 7 and patented claim 8 of the '782 Patent are so close in content that they both cover the same thing, despite a slight difference in wording. This is a double patenting rejection.

Claim 9 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 10 of prior U.S. Patent No. 6,679,782. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_\_, Frame\_\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_\_ To:\_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,679,782. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '782 Patent are more specific than the instant claims and thus encompass all of the limitations of the instant claims. Moreover, the following specific observations are made with respect to the pending claims, when compared to the claims of the '782 Patent:

As to instant claim 1, note claim 1 of the '782 Patent, wherein the only difference is that the claimed invention of the '782 Patent includes an alignment means and a grip.

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As the alignment means serve the purpose of helping a golfer align the club head with an intended target, it is clear that simply removing the alignment means from the claimed invention of the '782 Patent would have been obvious to the skilled artisan, since it has been held that the removal of element in a device along with the removal of its associated function would have been obvious to the skilled artisan at the time of the invention, so long as the remaining elements in the device perform as intended. See In re Karlson 136 USPQ 184. In this case, the removal of the alignment means enables the remaining claimed elements of the '782 Patent to perform as usual. With respect to the claimed grip attached to the shaft in the '782 Patent, it is clear that the grip may be removed, wherein the skilled artisan would have simply provided for a portion of the shaft itself to be gripped by a player, as provided by the teaching reference to Wallo (col. 2, lines 1-3).

As to instant claim 2, see claim 4 of the '782 Patent.

As to instant claim 3, see claim 5 of the '782 Patent.

As to instant claim 4, see claim 9 of the '782 Patent.

As to instant claim 5, see claim 3 of the '782 Patent, wherein the only difference is that the claimed invention of the '782 Patent includes an alignment means and a grip. As the alignment means serve the purpose of helping a golfer align the club head with an intended target, it is clear that simply removing the alignment means from the claimed invention of the '782 Patent would have been obvious to the skilled artisan, since it has been held that the removal of element in a device along with the removal of its associated function would have been obvious to the skilled artisan at the time of the



invention, so long as the remaining elements in the device perform as intended. See In re Karlson 136 USPQ 184. In this case, the removal of the alignment means enables the remaining claimed elements of the '782 Patent to perform as usual. With respect to the claimed grip attached to the shaft in the '782 Patent, it is clear that the grip may be removed, wherein the skilled artisan would have simply provided for a portion of the shaft itself to be gripped by a player, as provided by the teaching reference to Wallo (col. 2, lines 1-3).

As to instant claim 6, see claim 6 of the '782 Patent, wherein the only difference is that the claimed invention of the '782 Patent includes an alignment means and a grip. As the alignment means serve the purpose of helping a golfer align the club head with an intended target, it is clear that simply removing the alignment means from the claimed invention of the '782 Patent would have been obvious to the skilled artisan, since it has been held that the removal of element in a device along with the removal of its associated function would have been obvious to the skilled artisan at the time of the invention, so long as the remaining elements in the device perform as intended. See In re Karlson 136 USPQ 184. In this case, the removal of the alignment means enables the remaining claimed elements of the '782 Patent to perform as usual. With respect to the claimed grip attached to the shaft in the '782 Patent, it is clear that the grip may be removed, wherein the skilled artisan would have simply provided for a portion of the shaft itself to be gripped by a player, as provided by the teaching reference to Wallo (col. 2, lines 1-3).

Claims 1, 7 and 8 are objected to because of the following informalities:

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As to claim 1, line 9, "to" should read --toe--;

As to claim 7, line 10, --the-- should follow "from";

As to claim 8, line 8, "to" should read --toe--.

Appropriate correction is required.

All references cited during the examination of applicant's prior patent application contained within the cross-reference to related applications are deemed pertinent to the instant application and are incorporated herein by reference. Copies of these references are not be provided with this Office action. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's prior Patents including Pat. Nos; '125, '600, '656, '391 and '302 are cited for the convenience of the applicant.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
May 17, 2004